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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,669	06/01/2000	Thomas Moran	673-1005	4523
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BARNES & THORNBURG, LLP			MILLS, DONALD L	
P.O. BOX 2786			ART UNIT	
CHICAGO, IL 60690-2786			PAPER NUMBER	
			2662	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/585,669

Applicant(s)

MORAN, THOMAS

Examiner

Donald L. Mills

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 60-65 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Regarding claims 60 and 62, when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. However, claims 60 and 62 do not express such a structural and functional relationship. Until the claims are structured to reflect such a limitation, the claims will remain non-statutory subject matter.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 35-41, 43-51, and 60-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda.

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Regarding claims 1, 51, 60, and 62, Beyda discloses subconference calling, which comprises:

*Forming a main conference between a plurality of users* (Managing subconference calls within a main conference. See Abstract;)

*Presenting at least one of said users in the main conference with a graphical list of the main conference participants* (Referring to Figures 1 and 2, the a list of users must inherently be presented to an user in order for them to determine an appropriate subconference participant. See column 5, lines 31-41;)

*Providing said user with an interface to interact with said graphical list of main conference participants, such that said user has an option to request a subconference with a subset of other users by selecting subconference participants from said graphical list using said interface* (Referring to Figure 1, first terminal 14 transmits a subconference call request 28 to the sixth terminal 24, based upon the inherently known list of participants. See column 4, lines 33-40;)

*Forming a subconference between the user and the subset of other users* (The subconference call subsystem 30 establishes a first subconference call. See column 4, lines 52-54;)

*Maintaining private from the main conference at least some communication between the subset of users in the subconference during the subsistence of the subconference* (Referring to Figure 2, data router 36 transmits voice data generated from the first terminal 14 and sixth terminal 24 over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

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*Presenting to said user a graphical list of the subset of users in the subconference, when the subconference is in progress* (Referring to Figures 1 and 2, the list of the subset of users in the subconference is inherently present during the subconference between the first terminal 14 and the sixth terminal 24. See column 4, lines 66-67 and column 5, lines 1-3.)

Regarding claim 36, Beyda discloses *wherein those users in the subconference are entirely isolated from participation in the main conference during the subsistence of the subconference* (Referring to Figure 2, data router 36 transmits voice data generated from the first terminal 14 and sixth terminal 24 over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

Regarding claim 37, Beyda discloses *wherein the users in the subconference are prevented from contributing to the main conference but are able to monitor communications in the main conference during the subsistence of the subconference* (Voice data generated from first terminal 14 and sixth terminal 24 are transmitted only to participants in the subconference call and voice data from the main conference call is transmitted to all terminals. See column 4, lines 57-62.)

Regarding claims 38 and 61, Beyda discloses *wherein the main conference utilizes a plurality of media types, users in the subconference utilize one or more of said media types, and users in the subconference can actively or passively participate in the main conference in at least one media type during the subsistence of the subconference* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

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Regarding claim 39, Beyda discloses *wherein the users utilize a plurality of media types in the main conference and/or subconference, said media types being selected from the group consisting of video, audio and data signals* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 40, Beyda discloses *wherein the media types utilized in the main conference include video and audio, and wherein the subconference utilizes audio signals* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 41, Beyda discloses *wherein the media types utilized in the main conference include audio and data, and wherein the subconference utilizes data signals* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 43, Beyda disclose *wherein the users in the main conference are not presented with said subconference list during the subsistence of the subconference* (Referring to Figures 2, 3, and 6, the subconference subsystem prevents any second voice data 38 from the first subconference call from being transmitted over the main conference call. See column 6, lines 61-63. And, the subconference call subsystem 30 establishes the call in a manner that is transparent to the other terminals in the main conference call. See column 4, lines 54-57.))

Regarding claim 44, Beyda discloses *wherein the main conference is formed on a conference bridge to which each of the main conference users is connected* (The main conference is routed a data router 36, or by a switch, hub, or bridge where the IP telephony terminals are connected. See column 4, lines 20-26.)

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Regarding claim 45, Beyda discloses *wherein the subconference users remain connected to the bridge and the subconference is formed by creating a second conference on the bridge simultaneously with the main conference* (The subconference call subsystem 30 establishes the call in a manner that is transparent to the other terminals 16, 18, 20, and 22 in the main conference call, which inherently resides on the same data router 36. See column 4, lines 54-57.)

Regarding claim 46, Beyda discloses *wherein the user(s) to whom the request is addressed have the option of accepting or refusing to join the subconference, and wherein such acceptance or rejection determines whether or not they remain as part of said subset* (After transmitting the request to the sixth terminal 24, the subconference call subsystem 30 monitors for an acceptance to the call set-up request which can be accepted or rejected, which inherently determines whether the sixth terminal 24 forms a subconference with the first terminal 14. See column 4, lines 50-52.)

Regarding claim 47, Beyda discloses *wherein each user in the subconference is provided with the option to leave the subconference at any time during the subsistence of the subconference* (Referring to Figure 5, when a subconference call is established, at any time during the subconference call, any terminal participating in the subconference call can transfer to bi-directional transmission within the main conference call. See column 6, lines 27-30.)

Regarding claim 48, Beyda discloses *wherein users opting to leave the subconference are automatically returned to full participation in the main conference* (Any terminal that can transfer among each of its subconference calls and the main conference call. See column 6, lines 30-34.)

Regarding claim 49, Beyda discloses *wherein users in the subconference are presented with the option of requesting one or more of the other subconference users to join a nested subconference within said initial subconference* (Referring to Figures 3, 4, 5, and 7, the subconference subsystem 30 monitor the main conference call and the first subconference call for a second request to establish a second subconference call. See column 7, lines 6-10.)

Regarding claim 50, Beyda discloses *wherein users in the subconference are presented with the option of requesting one or more of the other subconference users to leave said initial subconference and from a new subconference without rejoining the main conference* (Referring to Figure 5, the fourth terminal 20 can establish a second subconference call from either the first subconference call or the main conference call. See column 6, lines 14-16.)

Regarding claim 63, Beyda discloses *means for enabling the user to select one or more media types for use during said subconference* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 64, Beyda discloses *when embodied in a multimedia terminal for use in a conference* (Referring to Figure 2, multimedia terminals 14 and 24.)

Regarding claim 65, Beyda discloses *when embodied in the form of a telephone handset having a graphical display for presentation of said graphical list and input means for operation of said interface* (Referring to Figure 2, multimedia terminals 14 and 24.)

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 42, 52-55, and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda, in view of Hamilton (US 6,757,259 B1).

Regarding claims 42 and 58 as explained in the rejection statement of claims 35 and 51, Beyda discloses all of the claim limitations of claims 35 and 51 (parent claim).

Beyda does not disclose *wherein the users in the main conference are presented with said subconference list during the subsistence of the subconference.*

Beyda teaches that when a coordinator drops parties from the conference call to establish a subconference call, the other coordinators in the call are able to detect that some parties have been dropped (See column 2, lines 2-5.)

It would have been an obvious choice in design to one of ordinary skill in the art at the time the invention was made to allow users in the main conference to see the list of subconference users. One of ordinary skill in the art at the time the invention was made would have been motivated to do so in order for users to establish subconferences with any user present in the conferencing system.

Regarding claim 52 as explained in the rejection statement of claim 51, Beyda discloses all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose *wherein the main conference list memory unit and the subconference list memory unit are logical areas within a single memory unit.*

Hamilton teaches a conference bridge comprising all memory within a central unit (See Figure 1.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the memory units as a single memory unit of Hamilton in the subconferencing system of Beyda. One of ordinary skill in the art at the time of the invention would have been motivated to do so in order to simplify system design, reduce system costs, and improve efficiency.

Regarding claim 53 as explained in the rejection statement of claim 51, Beyda discloses all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose *wherein the functions of the main signal processing means and of the subconference signal processing means are carried out by the same signal processing unit.*

Hamilton teaches a conference bridge comprising all signal processing within a central unit (See Figure 1.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the signal processing as a single signal processing unit of Hamilton in the subconferencing system of Beyda. One of ordinary skill in the art at the time of the invention would have been motivated to do so in order to simplify system design, reduce system costs, and improve efficiency.

Regarding claim 54, the primary reference further teaches *wherein said signal processing unit is adapted to combine signals of different media types* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

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Regarding claim 55, the primary reference further teaches *wherein said media types are selected from video, audio and data* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 57, the primary reference further teaches *wherein said main control unit includes means for forwarding said list of users in the conference to each of the users* (Referring to Figure 1, first terminal 14 transmits a subconference call request 28 to the sixth terminal 24, based upon the inherently known list of participants. See column 4, lines 33-40.)

Regarding claim 59, the primary reference further teaches *a conferencing server connected to the conferencing server, and means for connecting users to the call server* (Managing subconference calls within a main conference. See Abstract.)

7. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda in view of Hamilton, further in view of Theimer et al. (US 5,812,865), hereinafter referred to as Theimer.

Regarding claim 56 as explained in the rejection statement of claim 51, Beyda discloses all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose the *subconference control unit being dynamically programmable causing said subconference signal processing means to generate outgoing signal streams containing a user selected combination of media types selected from the incoming signals for the users subconference.*

Theimer selectively establishing communications paths between media devices based on the context of the users. For example, user<sub>A</sub> may set up an electronic conference with user<sub>B</sub>.

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User<sub>A</sub> may specify that a video connection is preferred, and user<sub>A</sub> may also accept telephone, or voice only, connection (See column 27, lines 33-46.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the selective communications path method of Theimer in the system of Beyda. One of ordinary skill in the art would have been motivated to do so in order to provide a system which allows users to select media data paths between users to tailor conferences to a user's capabilities as taught by Theimer (See column 4, lines 10-13.)

### *Response to Arguments*

8. Applicant's arguments with respect to claims 35-65 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Mills whose telephone number is 571-272-3094. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Donald L Mills



December 10, 2005



**JOHN PEZZLO**  
**PRIMARY EXAMINER**